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10/729,232	12/05/2003	Roger Thomas	P-US-PR 1111	9216

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EXAMINER

SELF, SHELLEY M

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/729,232

Applicant(s)

THOMAS, ROGER

Examiner

Shelley Self

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 2,4 and 6-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/19/04; 12/5/03
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election with traverse of the Species of Figures 1-5, readable on claims 1, 3, and 5 in the reply filed on June 16, 2005 is acknowledged. The traversal is on the ground(s) that no serious burden exists to search and examine the entire application. This is not found persuasive because the application contains distinct inventions drawn to separate species. For example the species of figures 1-5 is clearly drawn to a planer, whereas the species of figures 6-8 and 9-12 are drawn to receptacles/containers classified in class 206 and therefore have divergent subject matter. Further the species of figures 1-5 differs from that of figures 13-15 and 16-18 in that structure differences are present. For example, the species of figures 1-5 has an upper wall, the species of figures 13-15 does not have an upper wall within the body of the planar, thus structurally divergent. Accordingly the species are distinct. Therefore, ~~a serious burden does~~ the inventions are s ~~exist and accordingly the species are separable and distinct.~~

Claims 2, 4 and 6-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 16, 2005.

The requirement is still deemed proper and is therefore made FINAL.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3 and 5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the following:

- Claims 1-14 of copending Application No. 10/729,233.
- Claims 1-13 of copending Application Nos. 10/729,234

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims of the presently presented application are merely-reworded versions of the co-pending applications, '233 and '234. The presently presented application claims a planer having a *shoe, body, cutting drum, motor, cutting blade, airflow generator, conduct and deflector connectable to the conduit*. The co-pending applications, '233 & '234 claims a planer comprising a *shoe, body, cutting drum, motor, cutting blade, airflow generator, conduit, deflector insertable into the planer body* (clm. 3; '233); *removable deflector* ('234) and flap ('234);. Examiner notes that the "connectable deflector" is understood to be able to be connected to the conduit and as such the terms "*deflector...insertable into*" ('233) and "*removable deflector*" ('234) and can be connected to the conduit. Thus the claims of the presently presented application fail to positively recite distinguishing patentable subject matter over those claims of co-pending applications (10/729,233; 10/729, 234)

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the *motor* (clm. 1) and *airflow generator* (clm. 1) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities:

The following phrases, terms are not understood:

- Pg. 4, line 29 “*sidewaysly*”
- Pg. 5, line 9, “*...rib is angled 35... ”*
- Pg. 7, line 17, “*...internal structure of the body 2 to of... ”*
- Pg. 7, line 18, “*...pivotal flap is its downward position*”
- P. 8, line 5, “*...wall of the body to of... ”*
- Pg. 9, line 11, “*...a one end an annular... ”*
- Pg. 9, line 12, “*...forms of the entrance... ”*
- Pg. 9, line 14, “*less than that of the in the diameter... ”*
- Pg. 11, line 27, “*Rod s 126... ”*

The specification should be reviewed for clarity. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. With regard to claim 5, neither the

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specification nor the drawings provide support for an exhaust aperture. Further the specification clearly defines a tubular aperture and expulsion aperture. The tubular aperture being formed through the body (pg. 4, lines 21-24) and the expulsion aperture formed in the wall (48) and the recess (50) of the cutting drum (pg. 5, line 20). It is unclear if "the exhaust aperture" (clm. 5) refers to either of the positively defined tubular or expulsion or aperture or if "the exhaust aperture" is an additional limitation. A clear understanding of the claimed invention could not be ascertained, accordingly the claim has not been further treated on the merits and no prior art has been applied. Clarification is necessary to facilitate a clear understanding of the claimed invention and proper application of the prior art.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 3 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3, recites, "the aperture" (line 6), there is insufficient antecedent basis for this term within the claim(s). It is unclear if whether the recitation, "the aperture" refers to an expulsion aperture ( clm. 3) or an aperture (clm. 1).

Claim 3 appears to contain allowable subject matter and would be allowable if the 35 U.S.C. 112 rejection were overcome.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Bellew et al.

(5,463,816). Bellew discloses a planer comprising a shoe (32), the shoe defining an aperture (fig. 5); a body (14) mounted on the shoe; the body including a wall (fig. 5) and the wall defining a recess (34); a cutting drum (28) rotatably mounted within the recess (fig. 5), the drum having a periphery and a portion of the periphery of the cutting drum projects through the aperture in the shoe (fig. 5); a motor (24) mounted within the body to rotatably drive the cutting drum; a cutting blade (40) mounted on the periphery of the drum (28) and adapted for cutting a work piece when the drum is rotating (col. 3, lines 6-9), the cutting action of the blade causing debris (col. 3, lines 6-9) created by the cutting to be ejected from the recess; an airflow generator (26) for producing an airflow within the body (col. 3, lines 21-25); a conduit (Examiner notes the opening to deflector assembly 12 acts as a conduit) defined within the body for directing the airflow, the conduit connected to the recess (fig. 5) for entraining and removing debris created by the cutting action of the blade (28); a deflector (12, 56; fig. 2) connectable to the conduit for guiding the air flow and entrained debris from within the body to outside of the body (col. 3, lines 28-32), the deflector having an interior and exterior (fig. 2); and wherein the conduit directs the airflow from the airflow generator (26), over the exterior of the deflector, then downward to the vicinity of the



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recess where debris is entrained by the airflow, and then to the deflector (12, 56) before it is guided by the deflector to outside of the body.

***Allowable Subject Matter***

Claim 3 contains allowable subject matter and would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if the 35 U.S.C. 112 rejection(s) were overcome.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or fairly suggest a planer comprising *debris to be ejected through an expulsion aperture along a first direction and the airflow in the conduit is directed to a point below the expulsion aperture and then is directed to be blown substantially along a second direction and the first direction of the debris and the second direction of the airflow intersect at an acute angle* in combination with the rest of the claimed limitations as set forth in claim 3.

The prior art reference, Bellew discloses a portable planer having a body mounted on a shoe, the shoe defining a recess wherein a rotatable cutting drum is mounted within the recess. Bellew discloses the cutting drum to have blades for removing material from a workpiece as the planer is moved along a surface of a workpiece. Further, Bellew discloses the planer to be motor driven and debris or chippings/shavings to be ejected from the planer through a deflector or ejection mechanism. Bellew discloses that as a workpiece is subjected to the cutting blade of the cutting drum, debris is passed from a recess (34) through an opening (46) into an evacuation chamber (expulsion aperture). To facilitate ejection of the debris, Bellew discloses the use of a

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fan/impeller to generate airflow within the planer and as the debris is passed from the recess to the opening to the evacuation chamber, the debris joins the airflow from the fan/impeller(26) and is directed to a deflector assembly for ejection from the planer. Bellew does not disclose a first direction of the debris and a second direction of the airflow and intersection of the first and second directions at an acute angle. Accordingly, Bellew fails to anticipate or render obvious the claimed invention as set forth in claim 3.

Neither the prior art of record nor any combination thereof discloses the claimed invention as set forth in claim 3. therefore claim 3 contains allowable subject matter.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf

August 17, 2005



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